APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,454	01/16/2001	David Trop	3754-0149	5281

22440 7590 12/18/2003		EXAMINER	
GOTTLIEB RACKMAN & REISMAN PC		D AGOSTA, STEPHEN M	
270 MADISON AVENUE			
8TH FLOOR		ART UNIT	PAPER NUMBER
NEW YORK, NY 100160601		2683	

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-26* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-26* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All b) ☐ Some * c) ☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6) ☐ Other: .

DETAILED ACTION

Claim Objections

Claim 2 objected to because of the following informalities: Typo exists:
"…deliver said page to pager <u>only OF said payment</u>…" should be "…only IF said
payment….". Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 10 and 20 rejected under 35 U.S.C. 112, second paragraph, as being
indefinite for failing to particularly point out and distinctly claim the subject matter which
applicant regards as the invention. Who is being charged for the page, the caller or
called party? The examiner interprets the "pager subscriber" as being charged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

<u>Claims 1-16</u> rejected under 35 U.S.C. 103(a) as being unpatentable over

Gruchala et al. US 6,263,056 in view of Neustein US 5,473,667 and Foladare et al. US

5,960,064.

As per **claims 1 and 6**, Gruchala teaches a cellular/paging system (ie. CPP or

PPP) for sending a message to a subscriber of the system (title, abstract and figures 1-

2) comprising;

A pager adapted to receive a page (abstract teaches paging party pays and

figure 2 shows paging system)

A paging server adapted to receive a request for sending said page, said request

including information about the caller (C4, L31-58)

A payment server coupled to said paging server and adapted to charge one of said caller and said subscriber in accordance with predetermined rules (C1, L13-34 and C4, L15 to C5, 15 teaches rules for charging, specifically C4, L45 to C5, L15. Also C3, L10-23).

But is silent on to display a message from a caller to a subscriber.

The examiner notes that while the applicant teaches paging and payment servers, Gruchala teaches a Tandem/SCP/STP systems that perform the functions of these two servers as noted above).

Neustein teaches a paging system that provides caller information to the called party's display (C6, L32-43).

With further regard to claim 6, Gruchala **is silent on** automatic establishment of a communication link between subscriber and caller AND a return call request from said subscriber. **Foladare** teaches connection between subscriber and caller via a bridging/signaling unit (abstract and figures 1 and 3a-3c).

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that a message is displayed, to provide means for the user to identify the caller.

As per **claim 2**, Gruchala teaches claim 1 wherein said payment and paging servers cooperate to deliver said page to said pager only if said payment server determines method of payment for said page (C4, L45 to C5, L15 teaches determination of payment methods AND C3, L10-23).

As per **claim 3**, Gruchala teaches claim 1 **but is silent on** further comprising a conference switch responsive to a return call from said subscriber, said conference switch adapted to establish a communication link between said subscriber and said caller.

Foladare teaches a bridge/signaling unit whereby a caller and called party are connected (abstract and figures 1 and 3a-3c).

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that a conference switch is used to establish a link, to provide means for ease of connection between calling/called parties.

As per **claim 4**, Gruchala teaches claim 3 wherein said paging server is adapted to charge said one of said subscriber and said caller for said page and said return call (C4, L45 to C5, L15 teaches multiple ways to determine who pays).

As per **claim 5**, Gruchala teaches claim 1 further comprising a caller identifier that identifies an account associated with said caller, wherein said payment server charges said account for said page (C4, L45 to C5, L5 teaches ability to use calling party's account or credit card).

As per **claim 7**, Gruchala teaches claim 6 **but is silent on** wherein said switch is adapted to establish communication when said caller remains connected after making said page request.

Foladare teaches a bridge/signaling unit whereby a caller and called party are connected and that the caller remains connected (abstract and figures 1 and 3a-3c).

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala , such that switch connects calling/called party after page request, to provide for ease of connection between calling/called parties

As per **claim 8**, Gruchala teaches claim 6 wherein said caller is associated with a caller phone number (C4, L15 to C5, L15 teaches identifying user) **but is silent on** and wherein said switch is responsive to a number from said subscriber which is different from said caller telephone number.

Neustein teaches a paging system whereby caller profile is identified and the subscriber can determine various numbers by which the called party will respond (C4, L61-67). One skilled in the art would provide for a calling party to be associated with at least one number or more. Hence, a calling party that has access to multiple phones, ie. cell phone, business phone and home phone, can be identified as the same calling party.

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that the switch is responsive to a different number for the calling party, to provide means for one user to be associated with multiple calling numbers for ease of connection between calling/called parties.

As per **claim 9**, Gruchala teaches claim 8, wherein said switch is responsive to a toll free number whereby said subscriber does not pay for said return call (C4, L15 to C5, L15 discloses identifying calling party information, eg. toll call, as well as if the calling party can be billed for the return call, C3, L49-52).

As per **claim 10**, Gruchala teaches claim 9, wherein said pager server is arranged to generate a charge for said page (multiple options exist: abstract teaches CPP/PPP, caller's credit card account can be billed C4, L59 to C5, L4, call billed to called party, C5, L11-12).   The examiner notes that if CPP/PPP is not enabled, the called party is always billed.

As per **claim 11**, Gruchala teaches claim 9, wherein said pager server is adapted to charge the caller for said page (multiple options exist: abstract teaches CPP/PPP, caller's credit card account can be billed C4, L59 to C5, L4).

As per **claim 12**, Gruchala teaches claim 6, further comprising a payment server coupled to said pager server, said payment server being adapted to generate a charge associated with said page and said return call (abstract teaches PPP and C4, L15 to C5, L15 teaches SCP gathering/performing billing operations).

As per **claim 13**, Gruchala teaches claim 12, wherein said payment server is adapted to identify an account associated with said caller, said charge being sent to said account (C4, L50 to C5, L15 teaches billing calling party).

As per **claim 14**, Gruchala teaches claim 13, wherein said caller is associated with telephone set, said payment server being adapted to determine said account from said telephone set (C5, L5-15 teaches determination of calling phone number/set and billing account accordingly).

As per **claim 16**, Gruchala teaches claim 15, **but is silent on** wherein said paging server is adapted to send said digital messages to said pager.

Gruchala teaches cell/paging systems which can transmit/receive digital messages (cellular can receive SMS messages).

Neustein teaches a paging system that provides caller information to the called party's display (C6, L32-43) which reads on transmission/reception of a digital message.

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that a digital message is sent, to provide means for both analog and digital messages to be supported by the system.

Claims 17-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Gruchala/Neustein/Foladare in view of Checco US 5,859,898.

As per **claim 17**, Gruchala teaches a cellular/paging system (ie. CPP or PPP) for sending a message to a subscriber of the system (title, abstract and figures 1-2) comprising;

Generating a page request by a caller, Receiving page request and generating a page which includes a number associated with said caller AND Transmitting said page to said pager/subscriber (abstract teaches paging party pays and figure 2 shows paging system - The examiner notes that Gruchala teaches Tandem/SCP/STP systems that perform paging operations as are known in the art.)

But is silent on

Page includes information identifying caller

Receiving a return call request from the subscriber

Automatically establishing a voice channel between said subscriber and said caller in response to said return call request.

Neustein teaches a paging system that provides caller information to the called party's display (C6, L32-43).

Foladare teaches return call request and connection between subscriber and caller via a bridging/signaling unit (abstract and figures 1 and 3a-3c).

With further regard to claim 25, Gruchala teaches recording of a voice message (C4, L66 to C5, L4) **but is silent on** transcribing into a digital message and sending to user. **Checco** teaches analog voice messages are converted into digital information using standard analog-to-digital conversion. The voice PARS 408A may have, for example, an analog-to-digital converter for converting the <u>analog voice message into a digital message</u> suitable for storage on the voice and data messages storage 412. For example, a subscriber may have a preference to receive messages in e-mail format. The data messaging system may receive a message for the subscriber in any format for which a PARS is present. When the system determines that the message is for a particular subscriber, the subscriber's preferences (which may be stored, for example, in the voice and data message store 412) may be determined and the message may be converted into a preferred format. Alternatively, the message may be stored in the original format and be converted if necessary during upload in a manner described below (C9, L29-47).

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that the page includes caller information AND return request is used for auto-link connection AND voice messages can be digitized, to provide a system that automatically connects the calling/called parties AND provides a digitized voice message.

As per **claim 18**, Gruchala teaches claim 17, wherein said caller is associated with a phone number and wherein said return request is generated by the subscriber by using a return call number different then said caller phone number.

As per **claim 19**, Gruchala teaches claim 17, **but is silent on** further comprises putting the caller on HOLD after said page request is generated and in response to return call request establishing said voice channel between caller and subscriber by removing said hold.

Foladare teaches return call request, caller on HOLD and connection between subscriber and caller via a bridging/signaling unit (abstract and figures 1 and 3a-3c, #328, #332, #336).

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala, such that the caller is put on HOLD, to provide means for the called party to have time to call back the caller.

As per **claim 20**, Gruchala teaches claim 17 further comprising generating a charge for said page (C4, L15 to C5, L15 teaches multiple ways for the calling party to be charged. The examiner notes that if CPP/PPP is not enabled, the pager subscriber will always be charged).

As per **claim 21**, Gruchala teaches claim 17 further comprising generating a charge for said page and said return call (C4, L15 to C5, L15 teaches multiple ways for the caller to be billed OR called party to be billed, C3, L10-23).

As per **claim 22**, Gruchala teaches claim 21 comprising obtaining a caller account associated with caller and applying said charge to said account (C4, L15 to C5, L15).

As per **claims 23-24**, Gruchala teaches claim 21 comprising providing a set of rules based an identity of the callers and generating a charged based on said rules AND selecting set of rules by the subscriber (C4, L15 to C5, L15).

As per **claim 25**, Gruchala teaches claim 26 **but is silent on** comprising said paging server sends a code with said vocal message to said transcription station and wherein said message includes code to identify the caller.

Neustein teaches a paging system whereby the caller can be identified by a ID number or code (C6, L18-40).

It would have been obvious to one skilled in the art at the time of the invention to modify Gruchala , such that the message includes a user ID code, to provide means for the called party to see the digitized voice message and know who sent it via the code.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. DePaola et al. US 6,405,028 teaches CPP wireless service.
2. Meehan US 6,556,818 teaches fixed CPP charges.
3. Nightingale et al. US 6,546,238 teaches CPP bypass.
4. Carlsen et al. US 5,644,626
5. Fisch et al. US 4,873,520.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist on 703-306-0377.

SMD

WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600